



UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trademark Offic

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/905,293 | 08/01/97 | ROSOK | M 030436.46SU1 |

HM32/0929

MERCHANT GOULD SMITH EDELL
WELTER & SCHMIDT
WESTWOOD GATEWAY SUITE 400
11150 SANTA MONICA BLVD
LOS ANGELES CA 90025-3395

EXAMINER

DEVI, S

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 09/29/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/905,293

Applicant(s)
MJ Rosok et al.

Examiner
S. Devi

Group Art Unit
1641

☒ Responsive to communication(s) filed on Jul 7, 1998.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-52 ~~is~~/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-52 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Serial No. 08/905,293
Art Unit: 1641

Election/Restriction

- 1) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
- 2) Effective 7 February 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Technology Center 1600, Group 1640, Art Unit 1641.
- 3) Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22 and 28-31, drawn to a method for inhibiting or preventing immunoglobulin-induced toxicity, classified in class 424, subclass 130.1.
 - II. Claims 23, 24 and 33, drawn to a pharmaceutical composition comprising structurally altered immunoglobulin fusion protein, classified in class 424, subclass 133.1.
 - III. Claims 25-27, 32 and 34-36, drawn to a method of treating cancer or proliferative type disease, classified in class 424, subclass 174.1.
 - IV. Claims 37-40, drawn to a chimeric structurally altered BR 96 antibody, classified in class 424, subclass 133.1.
 - V. Claim 41, drawn to hBR96-B antibody, classified in class 424, subclass 133.1.
 - VI. Claim 42, drawn to hBR96-2C antibody, classified in class 424, subclass

- 133.1.
- VII. Claim 43, drawn to hBR96-2D antibody, classified in class 424, subclass 133.1.
- VIII. Claim 44, drawn to hBR96-2E antibody, classified in class 424, subclass 133.1.
- IX. Claim 45, drawn to hBR96-2F antibody, classified in class 424, subclass 133.1.
- X. Claim 46, drawn to hBR96-2G antibody, classified in class 424, subclass 133.1.
- XI. Claim 47, drawn to hBR96-2H antibody, classified in class 424, subclass 133.1.

Claims 48-52 are considered linking claims and will be joined with one of groups IV-XI if elected.

4) Inventions II, I and III are related as product and processes of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case, the processes of inventions I and III can be practiced with another materially different product such as a drug. The product of invention II can be used for *in vitro* research purposes.

Inventions IV, V, VI, VII, VIII, IX, X and XI are drawn to different antibody products that are structurally and/or functionally distinct from each other.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art as shown by their different classifications/subclassifications and divergent subject matters, restriction for examination purposes as indicated is proper.

5) Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Serial No. 08/905,293
Art Unit: 1641

6) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

7) A telephone conversation was placed to Mr. William J. Wood on 8 July 1998 to request an oral election for the restriction requirement set forth above. Mr. Wood requested that a written restriction requirement be mailed to him.

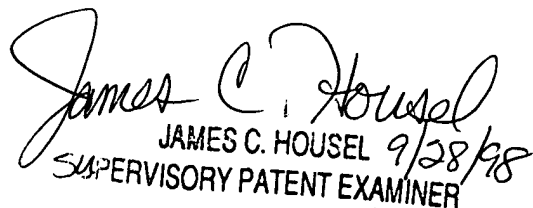
8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Devi whose telephone number is (703) 308-9347. The examiner can normally be reached on Monday to Friday from 7.45 am to 4.15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 305-7939.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



S. Devi
16 September 1998



JAMES C. HOUSEL 9/28/98
SUPERVISORY PATENT EXAMINER